

#4

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Baskaran Vijayakumar et al.

SERIAL NO.: 09/855,322

FILING DATE: May 14, 2001

TITLE: Matched Texture Filter Design for Rendering Multi-Rate Data Samples

EXAMINER: Unknown

ART UNIT NO.: 2857

ATTY., DKT. NO.: PA1742US

COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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PETITION UNDER 37 C.F.R. §1.47(a) AND DECLARATION OF FACTS

On behalf of the Applicants, we have made diligent efforts to reach the inventor Konstantine Iourcha, but have been unsuccessful in obtaining a signed Declaration from either inventor. The remaining Applicant hereby petitions the Commissioner to accept the filing of the above-reference patent application on his as well as the non-signing inventors' behalf. The last known address for Konstantine Iourcha is 310 Elan Village Lane, #204, San Jose, CA 95134.

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This Declaration of Facts is made as to the facts which are relied upon to establish diligent effort to secure the execution of the Declaration by the inventor Konstantine Iourcha, for the above-identified patent application.

This Declaration of Facts is being made by an available person having first-hand knowledge of the facts recited herein.

I, Susan Yee, hereby declare that:

1. I am employed by the law firm of Car & Ferrell LLP, which has a principal place of business at 2225 East Bayshore Road, Suite 200, Palo Alto, CA 94303.

2. I am a patent attorney licensed to practice before the U.S. Patent and Trademark Office. I represent the inventors and assignee for the purpose of prosecuting the above-identified patent application.

3. I mailed a letter to Mr. Iourcha on August 3, 2001 (Exhibit A). My colleague Jennifer Dupré then contacted Mr. Iourcha in October of 2001, at which time they discussed the need for Mr. Iourcha to sign the Declaration and Assignment. However, Mr. Iourcha did not sign the documents at that time. My colleague Jenny Splitter contacted Mr. Iourcha via telephone on March 18, 2002 regarding this application. At that time, he conveyed his refusal to sign the Declaration and Assignment. She also mailed a letter to Mr. Iourcha at his work address, 2805 Bowers Avenue, Santa Clara, CA 95051 (Exhibit B) enclosing the patent application, Declaration, and Assignment and again requesting his signature on these documents. He responded in writing (Exhibit C), and again refused to sign the Declaration and Assignment.

Jennifer Dupre responded to Mr. Iourcha (Exhibit D). However, he still refuses to sign the Declaration and Assignment.

I have at no time received an executed Assignment or Declaration from Mr. Iourcha and he maintains his refusal to sign any documents.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

All Doloz

Susan Yee

Susan Yee, Reg. No. 41,388
Carr & Ferrell LLP
2225 East Bayshore Road, Suite 200
Palo Alto, CA 94303
TEL: (650) 812-3400
FAX: (650) 812-3444



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August 3, 2001

(650) 812-3423

VIA CERTIFIED MAIL

Mr. Konstantine I. Iourcha
310 Elan Village Lane, #204
San Jose, CA 95134

Re: U.S. Patent Application Serial No. 09/855,322
 Filed: May 14, 2000
 Title: Matched Texture Filter Design for Rendering Multi-Rate
 Data Samples
 Our Ref.: PA1742US

Dear Mr. Iourcha:

Enclosed, please find a copy of the specification we filed in May. In addition we have enclosed an Assignment and a Declaration and Power of Attorney for your execution. Please sign and date both documents on the third page. After execution, please fax the documents and return the originals to me in the enclosed self-addressed envelope so that I can file them with the U.S. Patent & Trademark Office.

Additionally, under the official Rules of Practice in patent cases, a patent applicant and his attorney are under an affirmative duty to disclose all information which is material to the examination of the application. Within the scope of this duty is an obligation to submit all "prior art" of which the applicant and his attorney are aware. We regularly satisfy that obligation by preparing and sending an information disclosure statement to the Patent and Trademark Office a few months after filing an application.

Prior art includes publications, both U.S. and foreign, patented or not, which describe a device similar to that disclosed and claimed in the patent application, or which show something sharing a significant common concept or feature with the invention for which a patent is sought. Any such publication which predates the date of invention or was published more than a year prior to the filing date of the application must be disclosed. Any doubts on this matter should be resolved in favor of disclosure.

Also included in "prior art" is any public use, disclosure or offering for sale of the invention or any relevant device in this country by the inventor or others, more than one year prior to the filing date of the application, or any knowledge or use of the invention by others in this country prior to your date of invention. This would include, for example, any prior patented or unpatented devices of which you are aware. Photographs or brochures are usually the best to show this prior art, if available. Again, all doubts should be resolved in favor of disclosure.

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Mr. Iourcha:
August 3, 2001
Page 2

Failure to make a full disclosure, as described above, may seriously jeopardize the ability to enforce any patent that might issue, and willful failure to provide pertinent information may be considered a criminal offense, and grounds for invalidating any subsequently issued patent and can result in an action for damages against the patent owner.

Accordingly, we request that you submit to us copies of any prior art publications, and information regarding any other "prior art" of which you are aware and to which you might have access. Please try to have the above-mentioned materials sent to us as soon as possible, as we should submit the information disclosure statement within thirty days.

Please note also that the duty of disclosure is an ongoing duty throughout the pendency of the application. Accordingly, any prior art of which you become aware should be promptly forwarded to us.

If you have any questions, please do not hesitate to contact me.

Sincerely,

Susan Yee

SY:nxc
Enclosures

Jenny R. Splittler
CARR & FERRELL LLP
ATTORNEYS AT LAW
2225 East Bayshore Road Suite 200,
Palo Alto, CA 94303

March 31, 2002

Rc: U.S. Patent Application No. 10/052,613
Title: Fixed-Rate Block based Image Compression with Inferred Pixel Values
U.S. Patent Application No. 09/855,322
Title: Matched Texture Filter Design for Rendering Multi-Rate Data Samples
U.S. Patent Application No. 09/855,280
Title: Selective Super-Sampling/Adaptive Anti-Aliasing of Complex 3D Data

Dear Ms. Splittler:

I would like to assist you in your work on the above-referenced patent applications. As we discussed on the phone last week (and several months ago with Ms. Dupre), several important issues need to first be clarified to this end. Unfortunately, your letter (dated March 25, 2002) does not provide such clarification of the issues. Please let me reiterate these issues that need to be clarified.

1. The utility patent applications for the inventions titled "Matched Texture Filter Design for Rendering Multi-Rate Data Samples" and "Selective Super-Sampling/Adaptive Anti-Aliasing of Complex 3D Data" have been prepared/approved in final draft by December 2000 and all documents were ready to be filed with the U.S. Patent and Trademark Office.

In particular, the applications (for the inventions Matched Texture Filter Design for Rendering Multi-Rate Data Samples" and "Selective Super-Sampling/Adaptive Anti-Aliasing of Complex 3D Data) have been reviewed by me and the S3 Inc. legal counselors. The declarations have been previously signed/executed by me and the assignments have been signed/executed by me for assignment to S3 Incorporated.

Hence, you are not quite correct in saying that I have not yet specifically assigned the ownership of these inventions.

2. The "Employee's Proprietary Information and Invention Agreement" between S3 Incorporated and myself have provisions stating that all my inventions made at that time shall be the sole property of the S3 Incorporated and its assigns.

I am aware that some intellectual property possibly has been transferred from S3 Incorporated/SonicBlue Inc. to S3 Graphics Inc.

Jenny R. Splitter
March 31, 2002
Page 2 of 3

However, I do not have any documents, which can be easily authenticated and state that the ownerships rights have been transferred specifically in the inventions referenced above.

Even if the prior assignments have not been executed, I cannot assign the inventions to the S3 Graphics Co., Ltd. until such documents are provided for my reference.

3. For the reasons unknown to me, the prepared utility applications mentioned in the above p.1 have not been filed with the U.S. Patent and Trademark Office by S3 Incorporated in year 2000 or later by S3 Graphics Co. Ltd. after the rights to the inventions has presumably been transferred.

For the reasons unknown to me, somebody authorized rewriting/edits of the utility applications for the inventions mentioned in p.1 (after I approved the final drafts). As an inventor, I have not been consulted on the matter.

As you understand, I have certain legal responsibilities in regard to the content of the applications. To sign the declarations, I need to first perform a thorough review of the rewritten/edited applications, which may take considerable time.

4. "Employee's Proprietary Information and Invention Agreement" between S3 Incorporated and myself have provisions stating that S3 Incorporated shall compensate me at a reasonable rate for the time actually spent by me on the assistance in obtaining and enforcing patents after termination of my employment.

So, you are not quite correct in stating that the previous compensation is suppose to cover all my work on the patent applications referenced above after termination of my employment by S3 Incorporated.

I presume, that if the rights to the inventions were transferred to S3 Graphics Co Ltd., then this company should address the question of compensation.

7. The application titled "Fixed-Rate Block based Image Compression with Inferred Pixel Values" would especially require careful review. This is because the assignment draft for this invention lists Mr. Nayak as a co-inventor; however we did not work together since 1997; hence I have trouble understanding how this could happen.

Jenny R. Splitter
March 31, 2002
Page 3 of 3

8. As an inventor, I would like to see these patents to be filed as soon as possible. To this end, I would suggest you arrange the following:

a. Proper legal documents clarifying the ownership of the intellectual property in question. As an example, please provide a letter from a SonicBlue corporate officer which:

- is written on a proper SonicBlue letterhead;
- states explicitly that the person writing the letter is authorized to make statements concerning the invention ownership transfer;
- lists transferred inventions (and applications) explicitly by the titles and serial numbers;
- requests and legally authorizes me explicitly to assign listed inventions to S3 Graphics Co. Ltd.;
- has a contact phone number of the SonicBlue corporate officer.;

b. A written contract to perform applications review based on an hourly rate of a professional of my qualification and a reasonable time estimate for review.

c. Separate declarations forms for the patent applications; S3 Graphics Co. Ltd. should sign/execute separate power of attorney documents.

It was my understanding, that we thoroughly reviewed the situation with Ms. Dupre several months ago on the phone and have complete understanding of the matters.

Sincerely,



* Konstantine Tousha

cc: Susan Yee, Carr & Ferrell LLP

Dr. Timour Paltashev, S3 Graphics, Inc.

Paul Shan, Via Technologies, Inc.

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1. Article Addressed to:

Konstantine I. Iourcha
310 Elan Village Lane #204
San Jose, CA 95134

7000 1670 0012 3095 8252

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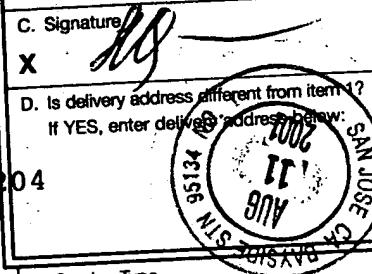
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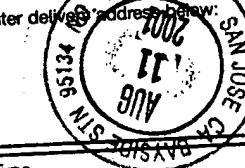
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Yes

CARR & FERRELL LLP

ATTORNEYS AT LAW

March 25, 2002

WRITER'S DIRECT DIAL NUMBER

(650) 812-3492

VIA CERTIFIED MAIL

Konstantine Iourcha
ATI Technologies Systems Corp.
ATI RESEARCH SILICON VALLEY INC.
2805 Bowers Avenue
Santa Clara, California 95051-0917

Re: U.S. Patent Application No. 10/052,613

Filed: January 7, 2002

Title: Fixed-Rate Block Based Image Compression with
Inferred Pixel Values

Our ref.: PA1732US

U.S. Patent Application No. 09/855,322

Filed: May 14, 2001

Title: Matched Texture Filter Design for Rendering
Multi-Rate Data Samples

Our ref.: PA1742US

U.S. Patent Application No. 09/855,280

Filed: May 14, 2001

Title: Selective Super-Sampling/Adaptive Anti-Aliasing of
Complex 3D Data

Our ref.: PA1743US

Dear Konstantine:

Enclosed please find a Declaration and Power of Attorney and Assignment for each of the above-referenced patent applications. For your reference, we have also enclosed a copy of the above-referenced patent applications as filed. Your contribution to these applications was for S3, Inc. S3 Graphics Co., Ltd. acquired certain intellectual property from S3, Inc., including the enclosed patent applications.

You made several requests regarding these patent applications, to which we respond here. In response to your request for a copy of each patent application, we have enclosed a copy of each of the above-referenced patent applications as filed.

Konstantine Iourcha

March 25, 2002

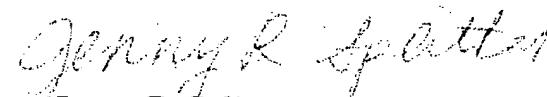
Page Two

Your contribution to the above-referenced patent cases, including signing the enclosed documents, is part of your employment for S3, Inc., for which you have already been compensated. In response to your concern regarding the assignment agreements, because you have not yet specifically assigned your ownership interest in the above-referenced patent applications, you can properly sign each of the enclosed Assignments.

Please sign, date, and complete the information where indicated by April 1, 2002. Please make any necessary address corrections in ink, and include your initials next to such changes. By executing the assignment you will be transferring ownership of the above-identified patent applications to S3 Graphics Co., Ltd. After execution of all the enclosed forms, please return the originals to me in the enclosed self-addressed envelope so that I can file them with the U.S. Patent & Trademark Office.

If you have any questions, please do not hesitate to contact me.

Sincerely,


Jenny R. Splitter

Enclosures

cc: Susan Yee

Konstantine Tourcea

facsimile transmittal

To: Jenny R. Splitter, and
Susan Yee

From: Konstantine Tourcea Date: 3/31/02

Re: Patent applications Pages:

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Notes: Please see attachment.

CARR & FERRELL LLP

ATTORNEYS AT LAW

WRITER'S DIRECT DIAL NUMBER

(650) 812-3469

VIA CERTIFIED MAIL

April 2, 2002

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Konstantine Iourcha
310 Elan Village Lane, #204
San Jose, CA 95134

Re: U.S. Patent Application No. 10/052,613

Filed: January 7, 2002

Title: Fixed-Rate Block Based Image Compression with
Inferred Pixel Values

Our ref.: PA1732US

U.S. Patent Application No. 09/855,322

Filed: May 14, 2001

Title: Matched Texture Filter Design for Rendering
Multi-Rate Data Samples

Our ref.: PA1742US

U.S. Patent Application No. 09/855,280

Filed: May 14, 2001

Title: Selective Super-Sampling/Adaptive Anti-Aliasing of
Complex 3D Data

Our ref.: PA1743US

Dear Konstantine:

We are in receipt of your letter of March 31, 2002. I am dismayed to see the same issues that I understood had been resolved in our conversation several months ago being raised yet again.

As you and I discussed several months ago, you were hesitant to sign inventor assignments in favour of S3 Graphics Co., Ltd. until you could independently verify that, in fact, these inventions were assigned to S3 Graphics Co., Ltd. by SONICblue Incorporated, as successor in interest to S3 Incorporated. My understanding is that this document has now been sent to you, and in fact, should already have been received by you. You informed me in our prior conversation that upon verification of S3 Graphics Co., Ltd.'s ownership of the

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2225 EAST BAYSHORE ROAD, SUITE 200, PALO ALTO, CA 94303
TELEPHONE (650) 812-3400, FACSIMILE (650) 812-3444
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Konstantine Iourcha

April 2, 2002

Page Two

inventions in question, you would sign the patent assignment documents. Accordingly, we look forward to you doing so.

With regard to the utility patent applications for the inventions entitled "Matched Texture Filter Design for Rendering Multi-Rate Data Samples" and "Selective Super-Sampling/Adaptive Anti-Aliasing of Complex 3D Data," this is again an issue that not only have you and I previously discussed, but you have discussed with Susan Yee. I explained that while it is true that you had reviewed the applications and had signed the assignment documents in favour of S3 Incorporated, for whatever reasons, S3 Incorporated/SONICblue Incorporated chose to delay filing the applications. S3 Incorporated then assigned these inventions to S3 Graphics Co., Ltd. At that point, S3 Graphics Co., Ltd.'s attorneys were obligated, by the professional rules of conduct, to review the applications to ensure that they were comfortable filing the work under their names. Unfortunately, it turns out that they were not, deeming the applications in need of substantial revision in order to provide S3 Graphics Co., Ltd. with the full scope of protection to which it is entitled for these inventions. Further, Patent Office requirements have changed, requiring that the applications be revised. Thus, while I understand your frustration, it does not lessen your obligation, under the "Employee's Proprietary Information and Invention Agreement" to assign the inventions to S3 Incorporated's assignee – S3 Graphics Co., Ltd.

You further state that you are not willing to sign the inventor assignment documents until you have performed "a thorough review of the rewritten/edited applications, which may take some time." However, you have now had these applications for nearly a year. Certainly this is sufficient time to review the applications and approve them and/or comment on them. In fact, given that you have indeed communicated comments to my colleagues as to the substance of the applications, I can only conclude that you not only *have* reviewed the applications, but that you did so several months ago. Thus, your argument that you "need time" to review the applications is not well made.

I also note that you again raise the issue of compensation for your time spent in obtaining or enforcing the patents after termination of your employment. As you and I discussed, this is a contractual matter between you and S3 Incorporated/SONICblue Incorporated. While S3 Incorporated/SONICblue Incorporated assigned the inventions/patents to S3 Graphics Co., Ltd, they did not also assign their obligation to compensate you. Accordingly, this responsibility has remained with S3 Incorporated/SONICblue Incorporated. You clearly understood this when last we spoke, so it is unclear to me why you are yet again raising this issue. I had informed you that if you provide me with your employment agreement,

Konstantine Iourcha

April 2, 2002

Page Three

and any and all evidence of S3 Incorporated/SONICblue Incorporated's obligation of payment to you, that we would endeavour to assist you in obtaining such payment. To date, we have not received any such documentation from you.

As you are correct in your statement that "we thoroughly reviewed the situation" when you and I spoke several months ago, I am disappointed to see the same issues being raised, and challenged, yet again. As you have reviewed the relevant patent applications, and have received the assignment document, we look forward to receiving the fully executed inventor assignments as soon as possible. I would like to reiterate that if you provide us with the necessary documentation, we will be happy to communicate with S3 Incorporated/SONICblue Incorporated in an effort to effect payment to you of the appropriate sums.

If you have any questions or concerns regarding this or any other matter, please do not hesitate to contact me as soon as possible.

Sincerely,



Jennifer R. Dupré

Jennifer R. Dupré, Esq.

cc: Susan Yee, Esq.
Dr. Timour Paltashev, S3 Graphics, Inc.
Paul Shan, VIA Technologies, Inc.



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See Preparation Instructions

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